#9 Response 5/17/02 Official CJK 5/16/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF

KOUZARIDES Atty. Ref.: 620-128

Serial No.: 09/744,469 Group Art Unit: 1653

Filed: January 25, 2001 Examiner: Kam, C.

For: ASSAYS, METHODS AND MEANS FOR MODULATING NUCLEAR LOCALIZATION

* * * * *

May 15, 2002

RESPONSE

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

Sir:

This is in response to the Examiner's requirement for restriction, set forth in the Office Action dated March 15, 2002, in the above matter, the period for response having been extended up to May 15, 2002, by submission of the required petition and fee herewith. Applicants elect the subject matter of Group II (claims 2, 3, 10 and 11) for prosecution in this application. That election is made with traverse.

As the Examiner is aware, the present application represents the national phase of a PCT application. During the international phase, no lack of unity was found.

MPEP 1893.03(d) requires that an examiner, making a lack of unity of invention requirement, (1) list the groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique **special technical feature** in each group. Respectfully, no such specific explanation is provided by the Examiner here. The only justification offered by the Examiner is the general remark that "each group is directed to distinct chemical entities and/or methods which use different materials to produce different effects".

In requiring restriction, the Examiner makes reference to the PCT Rules and "special technical feature". However, it is respectfully submitted that the Examiner has not, in fact, applied the PCT rules.

In order that it will be clear as to what is meant by a "special technical feature", as defined in the PCT, attention is directed to 37 CFR 1.475(a) (the operative provision) which states:

> An international application before the International Searching Authority will be considered to have unity of invention if the claims are in accordance with PCT Rule 13.

PCT Rule 13 states:

> 13.1 Requirement
>
> The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").
>
> 13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled (underlining added)
>
> Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.
>
> (underlining added)

Thus, there is one and only one meaning for "special technical features". "Distinct" utilities or possible other uses, other chemical properties, physical structure are irrelevant and the PCT does not permit them to be taken into account. The sole test for unity is whether the is "one or more of the same or corresponding special technical features" as defined by the PCT, which is binding on this national phase application.

The Examiner's attention is directed to the fact that one contribution made by the present invention is the identification that CBP and Importin α interact. The interaction between the two proteins provides one contribution to the art that is reflected in all the claims as a special technical feature. The showing that one acetylates the other and thus has a biological relevance represents yet another novel and unobvious contribution to the art providing a further unifying special technical feature.

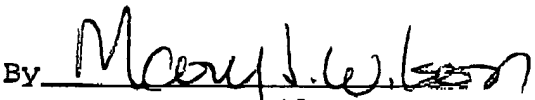
In view of the foregoing, the Examiner is requested to reconsider the requirement for restriction and rejoin all the claims. Should the Examiner be inclined to maintain the requirement, however, her/his attention is directed to the fact that claim 5, presently grouped in Group III, is drawn to an assay method for an agent that affects the ability of Importin α to (i) bind Importin β, (ii) translocate into the nucleus, +/or (iii) import a cargo protein - the Examiner is urged to compare this language to that of claim 3, which is included in Group II. It is believed that having made that comparison, the Examiner will find it appropriate to rejoin claim 5 (and claims 6-8 which depend therefrom) with Group II. If

considering maintaining the restriction requirement, the Examiner is also urged to reconsider the present grouping of claims 4 and 9 in Group I rather than Group II. By the Examiner's own definition of the subject matter of the two Groups, the inclusion of these 2 claims in Group II is clearly appropriate.

A response to the foregoing request for reconsideration is awaited.

Respectfully submitted,

NIXON & VANDERHYE, P.C.

By 
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